IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Akihiro IIDA et al.	Confirmation No.:	1352
Serial No.:	10/586,142	Art Unit:	1633
371(c) Date:	December 13, 2006	Examiner:	Michael D. BURKHART
Customer No.:	21559		
Title:	METHODS FOR PRODUCING MINUS-STRAND RNA VIRAL VECTORS USING HYBRID PROMOTER COMPRISING CYTOMEGALOVIRUS ENHANCER AND CHICKEN BETA-ACTIN PROMOTER		

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY TO RESTRICTION REQUIREMENT

In reply to the Restriction Requirement that issued in connection with the above-captioned case on October 12, 2010, Applicants elect the invention of Group II, claims 1, 3, 5-9, 16-19, and 24-28, and the species of the RNA-polymerase being expressed episomally. Claims 1, 3, 5, 7-9, 16-19, and 24-28 read on the elected invention. The election is made with traverse.

The Office states (page 2):

> The technical feature linking Groups I and II is using a CAG promoter to express minus-strand RNA viral protein that form a ribonucleoprotein, i.e. the NP, P and L proteins. Such a system is taught by Waning et al (J. Virol., 2002, pp. 9284-9297, cited by applicants). See the ¶ linking the first and second columns on page 9285: the pCAGGS vector comprises the CAG promoter (instant specification).

> Therefore, the technical feature linking the inventions of Groups I and II does not constitute a special technical feature as defined by PCT Rule 13.2, as it does not define a contribution over the prior art.

Applicants respectfully disagree.

Claim 1 is a generic claim that encompasses the embodiments of claims 2 and 3, i.e., Groups I and II. Applicants submit that the technical feature of claim 1 is use of a CAG promoter to express not only minus-strand RNA viral proteins that form a ribonucleoprotein with a viral genomic RNA, but also the viral genomic RNA or its complementary strand (parts (i) and (ii) of claim 1). In particular, transcription of the viral genomic RNA is induced directly or indirectly by the CAG promoter (see, e.g., page 6, lines 29-31 of the English language specification). The claims of both Groups I and II share this technical feature.

Applicants agree that Waning et al. (J. Virol. 76:9284-9297 (2002); "Waning") describes using the pCAGGS vector containing a CAG promoter. Waning, however, only uses the CAG promoter to express viral proteins (i.e., to express L, NP, and P proteins using pCAGGS-L, pCAGGS-NP, and pCAGGS-P, respectively) (see lines 7-8 of the right column on page 9285 of Waning). Waning does not describe using the CAG promoter to express the viral genomic RNA. Applicants submit that using the CAG promoter to express the viral genomic RNA links the inventions of Groups I and II and constitutes a special technical feature that provides a contribution over the prior art.

For the reasons set forth above, Applicants respectfully request reconsideration

and withdrawal of the present Restriction Requirement.

Enclosed is a Petition to extend the period for replying to the Restriction Requirement for four (4) months, to and including March 14, 2011, as March 12th is a Saturday, and an authorization to charge the required extension fee to Deposit Account No. 03-2095.

If there are any additional charges or any credits, please apply them to Deposit Account No. 03-2095.

Respectfully submitted,

Date: 11 March 2011

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